

REMARKS

Applicant has carefully studied the Final Office Action of December 5, 2005 and offers the following remarks to accompany the above amendments.

Applicant amends the specification to include the priority claim that has been asserted throughout the present application. Applicant notes that the Utility Transmittal Form submitted at the time of filing of the application included the priority claim as did the remarks to the preliminary amendment. The Patent Office erred in not including this priority claim on the filing receipt, but the filing papers clearly indicated the continuation status of the application. Thus, the claim to the parent application does not constitute an amendment as alleged by the Patent Office. Since the priority claim is not an amendment, the finality of the current Office Action is premature. Applicant requests withdrawal of the finality of the current Office Action.

Further, Applicant notes that the present application was filed in 1998, well before the changes to the laws and regulations promulgated on November 29, 2000, thus the various citations provided in paragraph 3 of the Office Action are not applicable to the present application. Thus, the current amendment does not necessitate a petition or a fee. If the Patent Office disagrees, Applicant requests that the Patent Office provide evidence as to the rule that was in effect in 1998 so that the procedures that were in place at the time of filing are used.

Applicant further amends the specification to eliminate an extraneous "either" on page 13. No new matter is added, but the sentence in question is made more comprehensible.

Applicant further amends the specification to provide identifying information for the incorporated applications. No new matter is added, but the incorporated material is more fully identified.

Applicant also amends claim 12 to correct a typographical error in the word "scrennail". No new matter is added, but a misspelling is corrected.

Claims 7-9, 11-18, and 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski et al. (hereinafter "Parulski") in view of Hayakawa et al. (hereinafter "Hayakawa"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element is taught or suggested in the prior art. MPEP § 2143.03.

Independent claims 7 and 22 recite that the image capture unit is a digital camera. Neither reference teaches a digital camera. The Patent Office asserts that a scanner is analogous

to a digital camera (see Office Action of December 5, 2005, page 5, line 6). Applicant traverses this assertion. Parulski is designed and intended to copy analog film such as from a 35 mm camera into digital files (see Parulski, col. 2, lines 46-54). Changing the scanner of Parulski into a digital camera involves modifying the reference. The Patent Office implicitly is modifying the scanner to a camera because otherwise the Patent Office has not established *prima facie* obviousness. To modify a reference in an obviousness determination, the Patent Office must first set forth a motivation to modify the reference, and second must support the motivation with actual evidence. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). If the modification makes the reference unsuited for its intended purpose, then the modification is non-obvious. MPEP § 2143.01(V).

The Patent Office provides no analysis as to why the scanner of Parulski would be modified to a digital camera, nor has the Patent Office provided any evidence to support the implied modification. Thus, the modification is improper. Even if the Patent Office had advanced some evidence to support the implicit modification, this modification remains non-obvious because the modification renders Parulski unsuitable for its intended purpose of copying analog film into a digital file.

Since the Patent Office has improperly modified Parulski, Parulski does not teach or suggest a digital camera. Likewise, the Patent Office has pointed to nothing in Hayakawa that teaches or suggests a digital camera. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

The dependent claims are allowable at least for the same reasons that the independent claims are allowable.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The combination of references does not teach that the image capture device is a digital camera as recited in the independent claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

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